

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Shrader et al.	§ Group Art Unit: 3685
Serial No.: 09/578,751	§ Examiner: Worjloh, Jalatee
Filed: May 25, 2000	§ Confirmation No.: 6562
For: Client-Side Pricing Agent for Collecting and Managing Product Price Information over the Internet	§ Attorney Docket No.: AUS000168US1

35525

PATENT TRADEMARK OFFICE
CUSTOMER NUMBER

Commissioner for Patents
P.O. Box 1450
Alexandria VA 22313-1450

RESPONSE TO NOTICE OF NON-COMPLIANT APPEAL BRIEF

Sir:

A Notice of Non-Compliant Appeal Brief was received by Applicant stating that “the appeal brief filed on July 10, 2006 is considered non-compliant because the Claims Appendix of the Appeal Brief is not consistent with the amendment filed on March 16, 2005”. A copy of the Notice of Non-Compliant Appeal Brief is attached hereto.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to Yee & Associates Deposit Account No. 50-3157. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Yee & Associates Deposit Account No. 50-3157.

REMARKS

In the Notification of Non-Compliant Appeal Brief, the Appeal Brief filed on July 10, 2006, was held defective because the Claims Appendix of the Appeal Brief is not consistent with the amendment filed on March 16, 2005. Particularly, claim 10, line 9 reads “associated price value, and a ary source”, whereas the amendment filed March 16, 2005 recites “...and a secondary source”. Claim 9, line 2 has also been amended to read “includes secondary source information”.

In order to address the Examiner’s concerns, a Replacement Appeal Brief is submitted herewith to correct the typographical error. It is respectfully submitted that the Replacement Appeal Brief filed herewith is in compliance with 37 C.F.R. § 41.37. Appellant respectfully requests that the Replacement Appeal Brief be entered.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: February 24, 2009

Respectfully submitted,

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Notification of Non-Compliant Appeal Brief (37 CFR 41.37)	Application No. 09/578,751	Applicant(s) SHRADER ET AL.	
	Examiner Jalatee Worjloh	Art Unit 3685	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The Appeal Brief filed on _____ is defective for failure to comply with one or more provisions of 37 CFR 41.37.

To avoid dismissal of the appeal, applicant must file an amended brief or other appropriate correction (see MPEP 1205.03) within **ONE MONTH or THIRTY DAYS** from the mailing date of this Notification, whichever is longer.
EXTENSIONS OF THIS TIME PERIOD MAY BE GRANTED UNDER 37 CFR 1.136.

1. ☐ The brief does not contain the items required under 37 CFR 41.37(c), or the items are not under the proper heading or in the proper order.
2. ☐ The brief does not contain a statement of the status of all claims, (e.g., rejected, allowed, withdrawn, objected to, canceled), or does not identify the appealed claims (37 CFR 41.37(c)(1)(iii)).
3. ☐ At least one amendment has been filed subsequent to the final rejection, and the brief does not contain a statement of the status of each such amendment (37 CFR 41.37(c)(1)(iv)).
4. ☐ (a) The brief does not contain a concise explanation of the subject matter defined in each of the independent claims involved in the appeal, referring to the specification by page and line number and to the drawings, if any, by reference characters; and/or (b) the brief fails to: (1) identify, for each independent claim involved in the appeal and for each dependent claim argued separately, every means plus function and step plus function under 35 U.S.C. 112, sixth paragraph, and/or (2) set forth the structure, material, or acts described in the specification as corresponding to each claimed function with reference to the specification by page and line number, and to the drawings, if any, by reference characters (37 CFR 41.37(c)(1)(v)).
5. ☐ The brief does not contain a concise statement of each ground of rejection presented for review (37 CFR 41.37(c)(1)(vi)).
6. ☐ The brief does not present an argument under a separate heading for each ground of rejection on appeal (37 CFR 41.37(c)(1)(vii)).
7. ☐ The brief does not contain a correct copy of the appealed claims as an appendix thereto (37 CFR 41.37(c)(1)(viii)).
8. ☐ The brief does not contain copies of the evidence submitted under 37 CFR 1.130, 1.131, or 1.132 or of any other evidence entered by the examiner **and relied upon by appellant in the appeal**, along with a statement setting forth where in the record that evidence was entered by the examiner, as an appendix thereto (37 CFR 41.37(c)(1)(ix)).
9. ☐ The brief does not contain copies of the decisions rendered by a court or the Board in the proceeding identified in the Related Appeals and Interferences section of the brief as an appendix thereto (37 CFR 41.37(c)(1)(x)).
10. ☒ Other (including any explanation in support of the above items):

The Claims Appendix of the Appeal Brief is not consistent with the amendment filed on March 16, 2005. Particularly, claim 10, line 9 reads "associated price value, and a ary source", whereis the amendment filed March 16, 2005 recites "...and a secondary source".

/Jalatee Worjloh/
Primary Examiner, Art Unit 3685

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	§ Group Art Unit: 3685
Serial No. 09/578,751	§
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REPLACEMENT APPEAL BRIEF (37 C.F.R. 41.37)

This brief is submitted as a replacement to the Appeal Brief originally filed on July 10, 2006.

No fees are believed to be required. If, however, any fees are required, I authorize the Commissioner to charge these fees which may be required to Yee & Associates Deposit Account No. 50-3157. No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and I authorize the Commissioner to charge any fees for this extension to Yee & Associates Deposit Account No. 50-3157.

REAL PARTY IN INTEREST

The real party in interest in this appeal is the following party: International Business Machines Corporation.

RELATED APPEALS AND INTERFERENCES

With respect to other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such appeals or interferences.

STATUS OF CLAIMS

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

Claims in the application are: 1-20

B. STATUS OF ALL THE CLAIMS IN APPLICATION

1. Claims canceled: 15-20
2. Claims withdrawn from consideration but not canceled: NONE
3. Claims pending: 1-14
4. Claims allowed: NONE
5. Claims rejected: 1-14
6. Claims objected to: NONE

C. CLAIMS ON APPEAL

The claims on appeal are: 1-14

STATUS OF AMENDMENTS

An amendment after Final Rejection was not filed. Therefore, Claims 1-14 on appeal herein are as amended in the Response to Office Action filed March 16, 2005.

SUMMARY OF CLAIMED SUBJECT MATTER

A. CLAIM 1 - INDEPENDENT

The subject matter of Claim 1 is directed to a method in a client computer for collecting product data. **Figure 1** shows a client computer **110** for implementing respective steps of the method, wherein the client computer is disposed to execute a pricing agent **130** as taught in the specification at page 11, lines 16-21. The pricing agent allows users to collect and manage information in an environment such as various web sites on the Internet. A first step of Claim 1 can be carried out by means of a pricing profile **302** of pricing database **300**, which is used with pricing agent **130** as shown by **Figure 3** and taught in the specification such as at page 13, lines 12-22 and page 14, lines 1-2, and also at page 6, line 23-page 7, line 2. This step recites generating, at the client computer, a profile identifying a site URL, an item to be queried and a scan interval. The next two steps of Claim 1, both performed at the client computer, comprise retrieving data from the site URL on a periodic basis defined by the scan interval, and parsing the retrieved data according to a site template. These steps are taught such as at page 7, lines 3-5 and page 15, lines 20-22. The final step of Claim 1, generating a data record at the client computer including an item name and a price value, is carried out by pricing agent **130** of **Figure 1** and price table **306** of **Figure 3**, as taught in the specification such as at page 18, lines 10-16.

B. CLAIM 10 - INDEPENDENT

The subject matter of Claim 10 is directed to a method in a client computer that includes steps and features that are similar to those of Claim 1. Claim 10 further recites a set of product profiles that each identifies a site template, as taught in the specification at page, 6 line 23-page 7, line 2. In addition, Claim 10 recites the step of storing data records at the client computer. The specification, such as at page 18, lines 10-16, teaches that this step can be performed by means of price table **306** of **Figure 3**.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

A. GROUND OF REJECTION 1 (Claims 1-9)

Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

B. GROUND OF REJECTION 2 (Claims 1-14)

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Streetprices.com (“Streetprices 1/99”).

C. GROUND OF REJECTION 3 (Claims 1-14)

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Streetprices 1/99 in view of U. S. Patent No. 6,785,671 (Bailey et al.), Muller’s Desktop Encyclopedia of the Internet (Muller) and Gralla’s How the Internet Works (Gralla).

ARGUMENT

A. GROUND OF REJECTION 1 (Claims 1-9)

Claims 1-9 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

The Final Office Action mailed February 7, 2006 alleged specific reasons only as to why Claims 1 and 6 were considered to be indefinite under 35 U.S.C. § 112, second paragraph. Thus, Claims 2-5 and 7-9 were rejected for indefiniteness solely because they respectively depend from Claim 1 and/or Claim 6. In rejecting Claim 1 under 35 U.S.C. § 112, second paragraph, the Examiner stated the following:

- a. In claim 1, it is unclear if the newly added “including” in line 9 modifies “record” or “computer.” [Office Action dated February 7, 2006, p. 3]

In order for the above Claim 1 language to be unclear, it must be reasonable to interpret language in the final step of Claim 1 to mean either “a data record including an item name and an associated price value,” or a “computer including an item name and an associated price value.” If one of these interpretations is reasonable and the other interpretation is not, Claim 1 is sufficiently clear and definite to meet all requirements of 35 U.S.C. § 112, second paragraph.

A.1. Claim 1 is Sufficiently Definite Under 35 U.S.C. § 112, Second Paragraph

The United States Patent and Trademark Office (USPTO), at **MPEP 2173.02**, provides clear and specific standards for analyzing definiteness under 35 U.S.C. § 112, second paragraph. These standards are as follows:

Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

Moreover, **MPEP 2173.02** stresses that the analysis for definiteness is to be reasonable. In view of these standards, the Claim 1 language at issue definitely and without question means “a data record including an item name and an associated price value”.

In regard to standard (A), pertaining to the content of the application disclosure, it is readily apparent that Applicants’ disclosure repeatedly emphasizes a data record that includes an item name and an associated price value. This is taught, for example, at page 7, lines 6-7 of the application. At page 18, line 10-page 19, line 3 of their specification, Applicants teach that price table **306** contains data records including both item names and price values. Moreover, original Claim 1 of Applicants’ disclosure recited “a data record comprising an item name and an associated price value”. On the other hand, Applicants’ specification nowhere discloses a computer that includes an item name or associated price value, nor do Applicants suggest any need therefor or benefit therefrom. Thus, the only reasonable interpretation of the current recitation of Claim 1, based on the above standard (A) of the USPTO, is a “data record including an item name and an associated price value”.

In regard to the other standards listed above for analyzing definitions, persons of ordinary skill in the art would readily recognize that it is commonplace, in computer related technologies, for data records to include an item name and an associated price value. Such persons of ordinary skill would also be familiar with the teachings of the prior art. These persons would further recognize that it would be unusual to refer to a “computer including an item name”. Such modifier is not a normal characteristic or attribute of a computer. Accordingly, persons of skill in the art would be led to search for a reason or purpose as to why such characterization was being used in connection with a computer. However, Applicants’ disclosure provides no basis whatever for a computer that includes an item name. Thus, those of skill in the art would reasonably interpret the language of Claim 1 to mean only “a data record including an item name and an associated price value”.

MPEP 2173.02 further teaches that in reviewing a claim for compliance with 35 U.S.C. § 112, second paragraph, it is necessary to “consider the claim as a whole”. Claim 1, in its current form, repeatedly recites a client computer as a claim element. However, no reason or basis is provided in Claim 1 for a client computer that includes an item name and an associated price value.

As shown by the records of the USPTO, the last amendment to Claim 1 made by Applicants was contained in their Response to Office Action mailed March 16, 2005. In the next following Office Action, which was a Final Office Action mailed June 3, 2005, the Examiner apparently found the amended Claim 1 to be sufficiently clear and definite, since Claim 1 was not rejected under 35 U.S.C. § 112, second paragraph. Applicants believe that this action of the Examiner in regard to Claim 1 was correct. Claim 1 was rejected as being indefinite under 35 U.S.C. § 112, second paragraph in the Final Office Action mailed February 7, 2006, which withdrew the Final Office Action of June 3, 2005.

A.2. Claim 6 is Sufficiently Definite Under 35 U.S.C. § 112, Second Paragraph

In rejecting Claim 6 for being indefinite, the Examiner stated the following:

b. Claim 6 is indefinite because the metes and bounds of the claim can not be determined. In particular, it is unclear if the phrase “wherein the profile includes matching criteria that must be met for the item name” in claim 6 is ‘in addition to,’ or ‘in replacement of,’ the phrase “generating a profile” as recited in claim 1. First, the Examiner starts with the presumption that all claim terms are presumed to have meaning in a claim. “While not an absolute rule, all claim terms are presumed to have meaning in a claim.” *Innova/Pure Water, Inc. v. Safari Water Filtration Sys.*, 381 F.3d 1111, 1119, 72 USPQ2d 1001, 1007 (Fed. Cir. 2004). , the Examiner adapts the presumption that there exists a difference in meaning and scope when different words or phrases are used in separate claims. “The doctrine of claim differentiation can shed light on the proper scope to be afforded a claim limitation, for there is presumed to be a difference in meaning and scope when different words or phrases are used in separate claims.” *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 53 USPQ2d 1065, 1070 (Fed. Cir. 1999) citations and quotations omitted). In this case, Applicant clearly uses “further including” in claims 2 and 3. Because claim 6 does not use “further comprising” or other phraseology in the preamble indicating they desire the subsequent limitations to be ‘additional’ limitations, and because Applicants’ use “further comprising in other claims, claim 6 has the presumption that it does not contain “further” limitations.

Because it does not contain additional or further limitations, it remains unclear if “the profile includes matching criteria that must be met for the item name” in claim 6 is ‘in addition to,’ or ‘in replacement of,’ the phrase “generating a profile” as recited in claim 1. Yet because the presumption has been established that the claim is interpreted to mean ‘in addition to,’ the only remaining interpretation is ‘in replacement of.’ **[Office Action dated February 7, 2006]**

Applicants consider that Claim 6, which depends directly from Claim 1, recites on its face that the profile of Claim 1, with the recited limitations of Claim 1, is additionally to include matching criteria that must be met for the item name. Applicants find no language in Claim 1, Claim 6 or any other of Applicants' claims, which suggests that the profile limitation of Claim 6 could be a replacement for the profile limitations of Claim 1, rather than an addition to such Claim 1 limitations. Thus, Claim 6 reads with sufficient clarity and definiteness to comply with the requirements of 35 U.S.C. § 112, second paragraph.

In the Final Office Action mailed February 7, 2006, the only basis for the indefiniteness rejection of Claim 6 appears to be some minor differences between the introductory phrase used in Claim 6, and the introductory phrase used in Claims 2 and 3. Claim 6 uses "includes", whereas Claims 2 and 3 (and Claim 5) use "further including". Because of their close similarity, a drafter of claims could very reasonably consider these two phrases to be equivalent or identical. Moreover, Claims 2, 3 and 5 were each drafted to add a further step to the method of Claim 1, whereas Claim 6 was drafted to add a further limitation to the profile of Claim 1. These differences could easily account for the minor differences in introductory phrase language used in the respective claims.

For at least all of the above reasons, Claims 1 and 6 are considered to be sufficiently clear and definite to meet all requirements of 35 U.S.C. § 112, second paragraph. Claims 2-5 and 7-9 respectively depend therefrom, and are likewise considered to be sufficiently clear and definite under 35 U.S.C. § 112, second paragraph.

B. GROUND OF REJECTION 2 (Claims 1-14)

Claims 1-14 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Streetprices.com ("Streetprices 1/99").

Independent Claim 1 reads as follows:

1. A method in a client computer for collecting product data, comprising the computer implemented steps of:
 - generating, at the client computer, a profile identifying a given site URL, an item to be queried, and a scan interval;
 - on a periodic basis as defined by the scan interval, retrieving data from the given site URL to the client computer;

parsing, at the client computer, the retrieved data according to a site template; and
generating a data record at the client computer including an item name and an associated price value.

B.1. Rejection of Claims

The Final Office Action mailed February 7, 2006 (hereinafter “Final Office Action”) rejected Applicants’ Claims 1-14 under 35 U.S.C. § 102(e) as being allegedly anticipated by Streetprices.com (website printout of January 25, 1999), hereinafter “Streetprices reference”. In rejecting these claims under 35 U.S.C. § 102, the Examiner stated the following:

9. Claims 1-14, as understood by the Examiner, are rejected under 35 U.S.C. § 102(e) as being anticipated by Streetprices.com (website printout of January 25, 1999) (“Streetprices 1/99”). Streetprices 1/99 discloses generating a set of product profiles (see *e.g.* “Computers”, “Flowers” and “Toys”), each identifying a given site URL (inherent); a list of one or more included items to be queried (the product to be searched), a scan interval (inherent in the graphs) and a site template (inherent in HTML and XML; periodically retrieving data from the given site URL (inherent in the x axis of the graph) according to the scan interval; parsing the data retrieved to generate a data record (inherent since it discloses the price over time); storing the data records (inherent); and the product profiles includes one or more triggers (a threshold price which sends an email when a price drops below a particular level). **[Office Action dated February 7, 2006, pp. 4-5]**

Applicants respectfully disagree with the above statement. The Streetprices reference does not explicitly or inherently teach the features of the present claimed invention and, thus, does not anticipate the claimed invention.

B.2. Teachings of Cited Reference

The Streetprices reference is clearly associated with a Web site that is embodied on an HTTP or other server. From the teachings of the Streetprices reference, a person of ordinary skill in the art will recognize that the Streetprices Web site or HTTP server receives a search query identifying a given product, obtains prices for the given product from selected e-commerce Web sites, and generates a return HTML document that presents the identified prices for the given product. Thus, the Streetprices Web server performs the functions of the Web site,

generates Web pages, and returns these pages to the client. As a person of ordinary skill in the art would instantly recognize, a browser client application on a client computer may request HTML Web pages from the Streetprices Web site. The only functions being performed at the client computer are requesting HTML documents, rendering HTML documents, displaying HTML documents, and, responsive to a user selecting a link in an HTML document, requesting further HTML documents.

B.3. Claim 1 Distinguishes over the Cited Reference

In contradistinction, the present invention, as exemplified by Claim 1, provides a method at a client computer for collecting product data. Implementing the functions of the claimed invention in a client computer presents several advantages. When a user generates a set of product profiles at a client computer, the user has much more control over the collection of product data. By generating the set of product profiles in the client computer, the user is able to designate a given site URL to be searched. That is, the user need not rely on a Web service to work out an agreement with e-commerce Web sites. Instead, the user may use any Web site he or she desires, as long as a URL is known for the given site.

In addition, the user may define a scan interval in the product profiles and have the client-side agent perform the search according to the scan interval defined by the user. Thus, the user has much more control over how often the product data collection is performed. On the other hand, with the Streetprices arrangement, the user is restricted to the scan interval rigidly defined at the Web server.

Moreover, the user need not depend upon a single Web server for operation. That is, if the Streetprices Web site is not operational, then the user is not able to collect product data. In addition, the Streetprices Web server may perform product data collection for thousands, even millions, of users. Thus, the performance of the Streetprices Web server can become degraded during peak usage. This single point of failure in the prior art is a disadvantage that is overcome by the present invention.

The Streetprices reference does not teach or suggest a method in a client computer for collecting product data, as is recited by independent Claim 1. Streetprices clearly teaches a Web site, which is embodied and executed on a Web server. The Web server of the Streetprices reference clearly is not a client computer, as required by Claim 1, particularly when read in light

of the present specification. The Final Office Action proffers no analysis whatsoever as to why a Web server is somehow a client computer. In fact, the Final Office Action appears to make no attempt whatsoever to address this limitation, other than to assert that it is inherent or obvious.

The Final Office Action misapplies the concept of “inherent” anticipation. Section 102 of Title 35 deals with novelty and loss of patent rights. Under the principles of inherency, a claim is anticipated if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim. *In re King*, 801 F.2d 1324, 231 U.S.P.Q. 136 (Fed. Cir. 1986). The missing claimed characteristics must be a “natural result” flowing from what is disclosed. *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 20 U.S.P.Q.2d 1746 (Fed. Cir. 1991). Unstated elements in a reference are inherent when they exist as a “matter of scientific fact.” *Constant v. Advanced Micro-Devices, Inc.*, 848 F.2d 1560, 7 U.S.P.Q.2d 1057 (Fed. Cir.), *cert. denied*, 488 U.S. 892 (1988) and *Hughes Aircraft Co. v. United States*, 8 U.S.P.Q.2d 1580 (Ct. Cl. 1988).

In the present case, the Examiner's assertion that these elements are present can be made only through the use of the Applicants' disclosure as a template to fill in the missing elements. The Final Office Action does not establish any necessity, natural result, or scientific fact to support a conclusion of inherency. The Final Office Action merely cites a reference directed to a Web site that is somewhat similar to the client-based invention, and simply dismisses all of Applicants' claim limitations as inherent.

What is known from the applied reference is that the Streetprices arrangement allows a user to enter a search term or click on a link for a product, collects price information from other Web sites, and generates a results page that is returned to the client. There is no evidence whatever in the Streetprices reference that a product profile is generated in a client computer, wherein the product profile includes a URL for a given site. Also, it does not naturally or necessarily flow from the teachings of the applied reference that a product profile is generated. There is no need for a product profile in the Streetprices Web site. There is also no need for a given site URL to be identified in a product profile, because the Streetprices Web site collects product information for thousands or more products for thousands or more users, rather than collecting product information for a handful of products from a given site for a single user at a client computer.

The Streetprices Web site need not collect price data periodically. Instead, the Streetprices Web site may collect data continually, and merely record price data based on a date of last change. Alternatively, the Streetprices Web site may look at a log listing the date of the page that was last scanned, and then determine whether the page needed to be scanned at all. There certainly is no evidence that a scan interval is included in a product profile generated in a client computer. As an alternative possibility not taken directly from Applicants' claims, the Streetprices Web site may collect data according to a scan interval hard coded in the server software.

For the above reasons, Applicants submit that missing elements are not inherently present in the disclosure of the cited Streetprices reference. Thus, the Final Office Action fails to establish a *prima facie* case of anticipation for Claim 1.

For at least all the above reasons, Claim 1 is not anticipated by the cited Streetprices 1/99 reference, and in its present form should be allowable over such reference.

B.4. Claim 10 Distinguishes over the Cited Reference

Claim 10 recites subject matter similar to that of Claim 1, and is considered to distinguish over the cited Streetprices reference for the same reasons given in support thereof. Moreover, Claim 10 recites a site template that a user may identify in a product profile for use when parsing the results from a given site. Thus, the user may control how the site is parsed, by providing a specific template for the site. On the other hand, the Streetprices reference provides no such teaching. With the Streetprices Web site, the user must rely on whatever parsing mechanisms are employed by the server software.

B.5. Claims Depending from Claims 1 and 10 Distinguish over Cited Reference

Claims 2-9 and 11-14 depend from and further restrict Claims 1 and 10, respectively. At least by virtue of their dependency on Claims 1 and 10, the respective features of dependent Claims 2-9 and 11-14 are not shown by, and thus overcome, the cited Streetprices reference.

At least for all of the above reasons, it is respectfully requested that the Board reverse the Examiner's final rejection under 35 U.S.C. § 102(e) of Claims 1-14.

C. GROUND OF REJECTION 3 (Claims 1-14)

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Streetprices 1/99 in view of U. S. Patent No. 6,785,671 (Bailey et al.), Muller's Desktop Encyclopedia of the Internet (Muller) and Gralla's How the Internet Works (Gralla).

In the Final Office Action, the Examiner stated the following in regard to the above rejection:

11. Claims 1-14 are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Streetprices 1/99 in view of Bailey et. al. (U.S. 6,785,671)(“Bailey”), Muller's Desktop Encyclopedia of the Internet (“Muller”), and Gralla's How the Internet Works (“Gralla”).¹ It is the Examiner's principle position that the claims are anticipated because the parsing is inherent and a profile identify a given a site URL is also inherent.

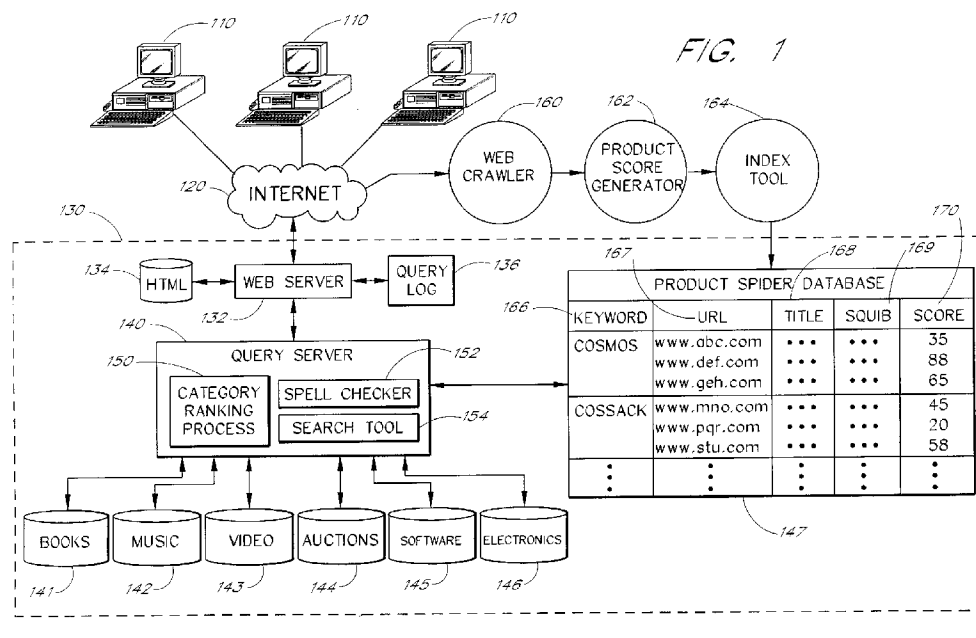
However if not inherent, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Streetprices 1/99 as taught by Bailey to include Bailey's parsing. Such a modification would have simply disclosed a feature that is already inherent in Bailey.

Regarding the generating the profile identifying a given site URL, this too is inherent in web crawler program. If web crawler programs does not generate an object, list, or profile identifying a given URL, that particular URL can not be searched. **[Office Action dated February 7, 2006, p. 5]**

The pertinent teachings of Streetprices are described above. Accordingly, it is necessary to consider the teachings of Bailey.

C.1. Teachings of Bailey Reference

Bailey teaches a web site that is embodied on a server. Figure 1 of Bailey is as follows:



Bailey states the following:

As shown in FIG. 1, the web site 130 includes a web server application 132 ("web server") that processes user requests received from user computers 110 via the Internet 120. These requests include queries submitted by users to search the on-line catalog for products. The web server 132 records the user transactions, including query submissions, within a query log 136. [col. 4, lines 28-34]

The Web server of Bailey performs the functions of the Web site, generates Web pages, and returns these pages to the client. As a person of ordinary skill in the art would instantly recognize, a browser application on a user computer may request HTML Web pages from the Web site. The only functions being performed at the user computer are requesting HTML documents, rendering HTML documents, displaying HTML documents, and, responsive to a user selecting a link in an HTML document, requesting further HTML documents.

Bailey fails to teach or suggest a method in a client computer for collecting product data, as presented in independent Claim 1. Bailey clearly teaches a Web site, which is embodied and executed on a Web server. The Web server of Bailey clearly is not a client computer, as recited in Claim 1, particularly when read in light of the present specification. The Office Action proffers no analysis whatsoever as to why a Web server is somehow a client computer. In fact, the Office Action appears to make no attempt whatsoever to address this limitation. Thus, it is

readily apparent that Bailey suffers from the same deficiencies as the Streetprices reference.

C.2. Claim 1 Distinguishes over any Combination of Cited References

In order to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, **MPEP § 2143** requires that there must be some suggestion or motivation in the prior art to modify the reference or to combine reference teachings as proposed, and the prior art or combined references must teach or suggest all the claim limitations. The suggestion to make the claim combination must be found in the prior art, not in the Applicant's disclosure. *In re Vacek*, 20 U.S.P.Q. 2d 1438 (Fed. Cir. 1991). Moreover, in accordance with **MPEP § 2141.02**, each prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates v. Garlock, Inc.*, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

As discussed above, Streetprices does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. For example, the Streetprices reference fails to teach a method in a client computer for collecting product data. Streetprices actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a method that is performed in a client computer, as in the presently claimed invention. In fact, the Streetprices Web site desires business activity, and clearly wants client computers to visit the Web site. Thus, the server-based Streetprices Web site would not lead a person of ordinary skill in the art to perform similar functions on a client computer, since there would be no server to control the distribution of, and exposure to, product related information.

Bailey suffers from the same deficiencies as the Streetprices reference. Bailey likewise teaches a web site that is embodied on a server. Bailey does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Bailey actually teaches away from the presently claimed invention because it teaches a Web site embodied and executed on a Web server, as opposed to a method that is performed in a client computer, as in the presently claimed invention.

It is readily apparent that if neither the Streetprices reference nor the Bailey reference

discloses an essential element of Claim 1, such as implementation of the method thereof on a client computer, it follows that no combination of such references can realize Claim 1. Even if one of the references could be modified by teachings of the other reference to show some claim elements, it would not matter. The principle cited above requires that the combined references disclose all claim elements. Clearly, no combination of references, wherein both references teach away from a feature, can teach or suggest the feature. Accordingly, no combination of Streetprices and Bailey can support a *prima facie* case of obviousness against Claim 1, under 35 U.S.C. § 103.

In the Final Office Action, the Examiner stated the following in regard to the cited Muller and Gralla references:

12. In this particular rejection, Muller and Gralla are cited simply to show those features of the Internet that are old and well known in the art yet silent in Streetprices 1/99 and Bailey. [Office Action dated February 7, 2006, p. 6]

Muller and Gralla are both references that provide information on different topics pertaining to the Internet. In the Final Office Action, there was no citation to any specific item of information in either Muller or Gralla. Neither was there any indication of specific items in Muller or Gralla that could be combined with Streetprices and/or Bailey, in order to overcome deficiencies thereof in regard to Applicants' Claim 1. The Final Office Action also provided no motivation or basis for combining information from Gralla or Muller with Streetprices or Bailey, in order to overcome the deficiencies of such references in regard to Claim 1.

C.3. No Basis for Combining References under 35 U.S.C. § 103

In order to combine references under 35 U.S.C. § 103, the prior art must show some reason or motivation for modifying one reference in accordance with teachings of another, in order to show the claim that is being rejected. However, in the Final Office Action no basis whatever has been provided, for combining the cited Streetprices, Bailey, Muller and Gralla references in regard to Claim 1. As discussed above, Applicants consider that both the Streetprices and Bailey references teach away from essential features of Claim 1. Accordingly, no *prima facie* case of obviousness can be made against Claim 1 based on a combination of these references, unless a basis for making the combination can be clearly shown by citations to

the prior art.

C.4. Claims 2-14 Distinguish over any Combination of Cited References

Claim 10 recites subject matter similar to that of Claim 1, and is considered to distinguish over any combination of the references cited under 35 U.S.C. § 103, for at least the same reasons given in support thereof.

Claims 2-9 and 11-14 depend from and further restrict Claims 1 and 10, respectively, and at least by virtue of this dependency are considered to distinguish over any combination of the references cited under 35 U.S.C. § 103.

At least for all of the above reasons, it is respectfully requested that the Board reverse the Examiner's final rejection under 35 U.S.C. § 103(a) of Claims 1-14.

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CLAIMS APPENDIX

The text of the claims involved in the appeal are:

1. A method in a client computer for collecting product data, comprising the computer implemented steps of:

generating, at the client computer, a profile identifying a given site URL, an item to be queried, and a scan interval;

on a periodic basis as defined by the scan interval, retrieving data from the given site URL to the client computer;

parsing, at the client computer, the retrieved data according to a site template and generating a data record at the client computer including an item name and an associated price value.

2. The method as described in Claim 1 further including the step of storing the data record.

3. The method as described in Claim 1 further including the step of:

comparing the associated price data to a given threshold condition; and taking a given action if the price data has a given relationship to the given threshold condition.

4. The method as described in Claim 3 wherein the given action is selected from the actions consisting essentially of issuing an e-mail notification, logging an event, and initiating an e-commerce transaction.

5. The method as described in Claim 1 further including the step of collecting associated price data for the item name over a given period of time to produce historical price data.
6. The method as described in Claim 1 wherein the profile includes matching criteria that must be met for the item name.
7. The method as described in Claim 6 wherein the matching criteria is an exact match.
8. The method as described in Claim 6 wherein the matching criteria is a fuzzy match.
9. The method as described in Claim 1 wherein the data record also includes secondary source information.
10. A method, in a client computer, of collecting product data, comprising the steps of:
 - generating a set of product profiles at the client computer, wherein each product profile within the set of product profiles identifies a given site URL, a list of one or more included items to be queried, a scan interval, and a site template;
 - for a given product profile, periodically retrieving data from the given site URL to the client computer according to the scan interval;
 - parsing, at the client computer, the data retrieved from the given site URL according to the site template to generate a data record for each included item comprising an item name, an

associated price value, and a secondary source; and
storing the data records at the client computer.

11. The method as described in Claim 10 wherein the given product profile also includes a list of excluded items.

12. The method as described in Claim 10 wherein the given product profile also includes a next scan date.

13. The method as described in Claim 12 wherein the given product profile also includes a threshold expression comprising a set of one or more triggers.

14. The method as described in Claim 13 wherein the given product profile also includes a threshold action that is triggered if the threshold expression resolves to a given value.

EVIDENCE APPENDIX

There is no evidence to be presented.

RELATED PROCEEDINGS APPENDIX

There are no related proceedings.